



7-23-04

FW

Docket No. 4303-4024US9

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Henry Marshall Israel et al.

Group Art Unit: 3731

Serial No.: 10/644,465

Examiner: TBD

Filed: August 20, 2003

For: Flexible Expandable Stent

EXPRESS MAIL CERTIFICATE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Express Mail Label No.: EV 245 501 373US

Date of Deposit: July 22, 2004

I hereby certify that the following attached paper(s) and/or fee

1. Information Disclosure Statement;
2. Form PTO 1449;
3. 88 references;
4. Change of Correspondence Address;
5. Return postcard.

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Susan Shen-Frattura

(Typed or printed name of person mailing papers(s) and/or fee)

(Signature of person mailing paper(s) and/or fee)

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CHANGE OF CORRESPONDENCE ADDRESS of Application Address to: Mail Stop <u>Amendment</u> Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	10/644,465
	Filing Date	August 20, 2003
	First Named Inventor	Henry Marshall Israel et al.
	Group Art Unit	3731
	Examiner Name	TBD
	Attorney Docket No.	4303-4024US9

Please change the Correspondence Address for the above-identified application to:					
Customer Number [27123] <i>Type Customer Number here</i>					
<input checked="" type="checkbox"/> Firm or Individual Name Morgan & Finnegan, LLP					
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I am the: <input type="checkbox"/> Applicant <input type="checkbox"/> Assignee of record of the entire interest. Certificate under 37 CFR 3.73(b) is enclosed. <input checked="" type="checkbox"/> Attorney or agent of record.					
Typed or Printed Name	Keith J. McWha		Registration No.	44,235	
Signature					
Date	July 22, 2004				



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For: FLEXIBLE EXPANDABLE STENT

INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Information Disclosure Statement is filed in accordance with 37 C.F.R.

§§1.56, 1.97 and 1.98. The items listed on Form PTO-1449, a copy of which is enclosed, are made of record to assist the Patent and Trademark Office in its examination of this application. The Examiner is respectfully requested to fully consider the items and to independently ascertain their teaching.

1. ☐ For each of the following items listed on the enclosed copy of Form PTO-1449 that is not in the English language, an English language translation of that item or a portion thereof or a concise explanation of the relevance of that item is enclosed:
2. ☐ For each of the following items listed on the enclosed copy of Form PTO-1449 that is not in the English language, a concise explanation of the relevance of that item is incorporated in the specification of the above-identified application.
3. ☒ Any copy of the items listed on the enclosed copy of Form PTO-1449 that is not enclosed with this Information Disclosure Statement was previously cited by or submitted to the Patent and Trademark Office in application Serial No. 09/971,616 (now U.S. 6,635,084), filed October 9, 2001.
4. ☒ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with:
☐ 37 C.F.R. §1.97(b)(1), within three months of the filing date of a national application other than a CPA; or

- ☐ 37 C.F.R. §1.97(b)(2), within three months of the date of entry into the national stage as set forth in §1.491 in an international application; or
- ☒ 37 C.F.R. §1.97(b)(3), before the mailing date of a first Office action on the merits; or
- ☐ 37 C.F.R. §1.97(b)(4) before the mailing date of a first office action after the filing of an RCE under §1.114.
5. ☐ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action), and is accompanied by one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below.
6. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a notice of allowance (where there has been no prior final action):
- ☐ A check in the amount of \$180.00 is enclosed in payment of the fee.
- ☐ Charge the fee to Deposit Account No. 13-4500, Order No. _____. A
DUPLICATE COPY OF THIS SHEET IS ATTACHED.
7. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(d), after the mailing date of a final action or a notice of allowance, whichever comes first, but before payment of the issue fee, and is accompanied by:
- a. ☐ one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below; and
- b. ☐ the fee due under 37 C.F.R. §1.17(p) which is paid as set forth in paragraph 11 below.
8. ☐ This Information Disclosure Statement is being filed in compliance with:
- a. ☐ 37 C.F.R. §1.313(b)(3) or §1.313(c)(1), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition To Withdraw Application From Issue and fee pursuant to 37 C.F.R. §1.17(h);
- b. ☐ 37 C.F.R. §1.313(c)(2) or §1.313(c)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Request for Continued Examination (RCE) or a Continuation application upon abandonment of the instant application and is accompanied by the attached Petition To Withdraw Application From Issue and fee pursuant to 37 C.F.R. §1.17(h).

- c. ☐ The fee due under 37 C.F.R. §§1.17(h) is paid as set forth in paragraph 11 below.
9. ☐ I hereby certify that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.
- ☐ I hereby certify that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.
10. ☐ This document is accompanied by ☐ a Search Report ☐ Communication which was cited in a corresponding ☐ PCT or ☐ Foreign counterpart application
11. ☐ A check in the amount of \$ _____ is enclosed in payment of the fees due under 37 C.F.R. §§1.17(h) and 1.17(p).
- ☐ Charge the fees due under 37 C.F.R. §§1.17(h) and 1.17(p) to Deposit Account No. 13-4500, Order No. _____. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4303-4024US9. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: July 22, 2004

By: _____

Keith J. McWha
Registration No. 44,235

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154-0053
(212) 758-4800 Telephone
(212) 751-6849 Facsimile

- c. ☐ The fee due under 37 C.F.R. §§1.17(h) is paid as set forth in paragraph 11 below.
9. ☐ I hereby certify that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.
- ☐ I hereby certify that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.
10. ☐ This document is accompanied by ☐ a Search Report ☐ Communication which was cited in a corresponding ☐ PCT or ☐ Foreign counterpart application
11. ☐ A check in the amount of \$ _____ is enclosed in payment of the fees due under 37 C.F.R. §§1.17(h) and 1.17(p).
- ☐ Charge the fees due under 37 C.F.R. §§1.17(h) and 1.17(p) to Deposit Account No. 13-4500, Order No. _____. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.
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FORM PTO-1449

INFORMATION DISCLOSURE CITATION

Attorney Docket:
4303-4024US9Serial No.:
10/644,465Applicant:
Henry Marshall Israel et al.Filing Date:
August 20, 2003Group Art Unit:
3731

U.S. PATENT DOCUMENTS

Examiner Initial		Patent Number	Issue Date	Name	Class	Sub-Class	Filing Date
		5,292,331	03/8/94	Boneau			
		5,383,892	01/24/95	Cardon et al.			
		6,461,380	10/8/02	Cox			
		5,405,377	04/11/95	Cragg			
		5,554,181	09/10/96	Das			
		5,514,093	05/7/96	Ellis et al.			
		5,643,312	07/1/97	Fischell et al.			
		5,879,370	03/9/99	Fischell et al.			
		5,314,472	05/24/94	Fontaine			
		5,268,534	12/7/93	Gailey et al.			
		4,800,882	01/31/89	Gianturco			
		5,282,824	02/1/94	Gianturco			
		5,035,706	07/30/91	Giantureo et al.			
		4,856,516	08/15/89	Hillstead			
		5,019,085	05/28/91	Hillstead			
		5,116,365	05/26/92	Hillstead			
		5,441,515	08/15/95	Khosravi et al.			
		5,593,442	01/14/97	Klein			
		5,540,712	07/30/96	Kleshinski et al.			
		5,733,303	03/31/98	Israel et al.			
		5,843,120	12/1/98	Israel et al.			
		5,972,018	10/26/99	Israel et al.			
		6,635,084B2	10/21/03	Israel et al.			
		5,649,952	07/22/97	Lam			
		5,158,548	10/27/92	Lau et al.			

FORM PTO-1449 INFORMATION DISCLOSURE CITATION				Attorney Docket: 4303-4024US9		Serial No.: 10/644,465	
				Applicant: Henry Marshall Israel et al.			
				Filing Date: August 20, 2003		Group Art Unit: 3731	
				U.S. PATENT DOCUMENTS			
Examiner Initial		Patent Number	Issue Date	Name	Class	Sub- Class	Filing Date
		5,421,955	06/6/95	Lau et al.			
		4,994,071	02/19/91	MacGregor			
		5,507,767	04/16/96	Maeda et al.			
		4,733,665	03/29/88	Palmaz			
		4,739,762	04/26/88	Palmaz			
		4,776,337	10/11/88	Palmaz			
		5,102,417	04/7/92	Palmaz			
		5,449,373	09/12/95	Pinchasik et al.			
		5,019,090	05/28/91	Pinchuk			
		6,156,052	12/5/00	Richter et al.			
		4,762,128	08/9/88	Rosenbluth			
		4,950,227	08/21/90	Savin et al			
		5,195,984	03/23/93	Schatz			
		5,354,309	10/11/94	Schnepp-Pesch et al.			
		5,443,496	08/22/95	Schwartz et al.			
		5,651,174	07/29/97	Schwartz et al.			
		5,354,308	10/11/94	Simon et al.			
		5,330,500	07/19/94	Song			
		4,922,905	05/8/90	Strecker			
		5,161,547	11/10/92	Tower			
		6,193,747	02/27/01	von Oepen			
		4,886,062	12/12/89	Wiktor			
		4,969,458	11/13/90	Wiktor			
		5,133,732	07/28/92	Wiktor			

FORM PTO-1449 INFORMATION DISCLOSURE CITATION				Attorney Docket: 4303-4024US9		Serial No.: 10/644,465	
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				Filing Date: August 20, 2003		Group Art Unit: 3731	
U.S. PATENT DOCUMENTS							
Examiner Initial		Patent Number	Issue Date	Name	Class	Sub- Class	Filing Date
		5,653,727	08/5/97	Wiktor			
		4,830,003	05/16/89	Wolff et al.			
		5,104,404	04/14/92	Wolff			
FOREIGN PATENT DOCUMENTS							
Examiner Initial		Patent Number	Publication Date	Country	Class	Sub- Class	Translation
		0 335 341	10/4/89	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		0 378 151	07/18/90	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		0 421 729	04/10/91	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		0 540 290	05/5/93	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		0 541 443	05/12/93	EP			<input type="checkbox"/> Yes <input checked="" type="checkbox"/> No
		0 566 807	10/27/93	EP			<input type="checkbox"/> Yes <input checked="" type="checkbox"/> No
		0 606 165	07/13/94	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		0 669 114	06/3/98	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		0 846 447	06/10/98	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		1 181 901	02/27/02	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		0 335 341	10/1989	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		0 540 290	5/1993	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		0 566 807	10/1993	EP			<input type="checkbox"/> Yes <input type="checkbox"/> No
		94/03127	02/17/94	PCT			<input type="checkbox"/> Yes <input type="checkbox"/> No
		95/26695	10/12/95	PCT			<input type="checkbox"/> Yes <input type="checkbox"/> No
		95/31945	11/30/95	PCT			<input type="checkbox"/> Yes <input type="checkbox"/> No
		96/03092	02/8/96	PCT			<input type="checkbox"/> Yes <input type="checkbox"/> No
		96/33671	10/31/96	PCT			<input type="checkbox"/> Yes <input type="checkbox"/> No
		10-500595	1/20/1998	JP			<input type="checkbox"/> Yes <input checked="" type="checkbox"/> No
		1-299550	12/4/1989	JP			<input type="checkbox"/> Yes <input checked="" type="checkbox"/> No

FORM PTO-1449 INFORMATION DISCLOSURE CITATION				Attorney Docket: 4303-4024US9		Serial No.: 10/644,465	
				Applicant: Henry Marshall Israel et al.			
				Filing Date: August 20, 2003		Group Art Unit: 3731	
FOREIGN PATENT DOCUMENTS							
Examiner Initial		Patent Number	Publication Date	Country	Class	Sub-Class	Translation
		6-181993	7/5/1994	JP			<input type="checkbox"/> Yes <input checked="" type="checkbox"/> No
OTHER DOCUMENTS (Including Author, Title, Date, etc.)							
		<p> Trial Transcript, Civil Action No. 99-904-SLR, pp. 2247-2256 (Reading of Jury Verdict). Jury Verdict, Civil Action No. 99-904-SLR, pp. 2247-2256. Docket, Civil Action No. 99-904-SLR. Defendants' Motion for Leave to File an Amended Answer and Counterclaim, Civil Action No. 99-904-SLR. Plaintiffs' Answering Brief in Opposition to Defendant' Motion for Leave to File an Amended Answer and Counterclaim, Civil Action No. 99-904-SLR. Appendix to Plaintiffs' Answering Brief in Opposition to Defendant' Motion for Leave to File an Amended Answer and Counterclaim, Civil Action No. 99-904-SLR. Reply Brief in Support of Defendant' Motion for Leave to File an Amended Answer and Counterclaim, Civil Action No. 99-904-SLR. Order of Aug. 15, 2001, Civil Action No. 99-904-SLR (relating to claim construction). Memorandum Opinion of Aug. 15, 2001, Civil Action No. 99-904 SLR (decision on summary judgment motions of non-infringement and validity). Order of Aug. 15, 2001, Civil Action No. 99-904-SLR (orders regarding decisions on summary judgment motions of non-infringement and validity). Second Supplemental IDS Letter, filed with the U.S. Patent and Trademark Office Jan. 18, 2001 for U.S. Ser. No. 09/337,629. Supplemental IDS Letter, filed with the U.S. Patent and Trademark Office Jan. 9, 2001 for U.S. Ser. No. 09/337,629. Excerpts from "Memorandum in Opposition to Plaintiffs' Motion for A Preliminary Injunction" <i>Scimed Life Systems, Inc. et al and Medinol, Ltd. v. Johnson & Johnson, et al.</i>, Civil Action No. 00404 SLR pp. (i)-(v) and 1-19 Redacted, pp. 20-28, pp. 29-41 Redacted. IDS Letter, filed with the U.S. Patent and Trademark Office Jan. 4, 2001 for U.S. Ser. No. 09/337,629. U.S. patent application Ser. No. 08/246,320, Burmeister et al., filed on May, 1994. European Search Report. Demand for Invalidation Trial in Japan. English translation of Written Refutation. Notice of Oppositions in Germany for EP 0 846 452 filed by Thomlinson, Cordis Corporation and Boston Scientific. Notice of Opposition in Germany for EP 0 846 450 filed by Cordis Corporation and Scimed. Notice of Opposition in Germany for EP 0 846 449 filed by Boston Scientific an Cordis Corporation. Demande's Reply Brief to Japanese Invalidation Trial. IDS Letter. </p>					
		Japanese Office Action citing list of references					
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Hearing, 8/8/2001					
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 1, 8/23/2001					
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 2, 8/24/2001					
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 3, 8/27/2001					
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 4, 8/28/2001					
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 5, 8/29/2001					
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 6, 8/30/2001					
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 7, 8/31/2001					

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		Applicant: Henry Marshall Israel et al.	
		Filing Date: August 20, 2003	Group Art Unit: 3731
		OTHER DOCUMENTS (Including Author, Title, Date, etc.)	
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 8, 9/4/2001	
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 9, 9/5/2001	
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 10, 9/6/2001	
		Scimed Life Systems, Inc, et al. vs. Johnson & Johnson, et al., Trial Vol. 11, 9/7/2001	
Examiner		Date Considered	
EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP §609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.			